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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/764,824   | 01/26/2004  | William T. Graushar  | 077047-9301-03      | 6908             |
| 23409  | 7590        | 07/21/2004           | EXAMINER            |                  |
| MICHAEL BEST & FRIEDRICH, LLP<br>100 E WISCONSIN AVENUE<br>MILWAUKEE, WI 53202 |             |                      | EICKHOLT, EUGENE H  |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2854                |                  |

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/764,824

Applicant(s)

GRAUSHAR ET AL.

Examiner

Eugene H Eickholt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5-18-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar 5100116 (of record in parent 6682062) in view of Rana.

Graushar has all the elements of the claims 1 and 5 except how the signature boxes 10 are mounted. The row of pocket boxes 10 constitute at least a pair of hoppers. Each box has a feeder associated with it. See col. 4, lines 10 and 17-18. An ink jet printer 120 recited in claim 4 is employed to print on the removed signatures. See col. 6, line 5 and fig.2. This reads on the ink jet of claims 4 and 6. A conveyor belt 106 transports the printed signatures to a primary feeder 132 after printing. See col. 7, lines 26-31. Column 8, lines 30-34 teach that the primary feeder 132 feeds the printed signatures to the "binding line" which is a finishing line as recited in claims 1 and 5.

Rana teaches supporting hopper pockets on a frame in the form of a control pipe 48. See col. 4, lines 10-13. At the time of applicants invention it would have been obvious to one of ordinary skill in the signature collecting art to have mounted the boxes 10 of Graushar on the Rana pipe 48. Motivation for such a modification is expressly set forth in Rana in the abstract to make the pockets removable for off-line adjustment.

Rana teaches the claim 2 horizontal stocking of signatures in the hoppers as shown in fig. 3. An overhead crane 62 can be used to lift and place the hoppers on or off the support pipe 48. Claim 7 calls for a plurality of two hopper feeders. Rana

teaches as many or as little as the job requires may be used by removing unneeded hopper pockets. Column 3 lines 13-15 teach that that a suitable feed out mechanism is associated with each hopper. Using only two such hopper pockets and their feeders would be an obvious matter of design choice dependent on the job requirements .

Regarding claim 2. it would have been obvious to have the Graushar pockets horizontally stacked as taught by Rana. Motivation would have been the ability to use the bottom feeder 30 of Rana shown in fig. 6 to remove horizontally stacked sheets.

Claim 5 calls for the hoppers feeders, the printer and a conveyor to be frame mounted. Graushar has ink jet print heads 120 and primary feeder 132 frame mounted as shown in fig. 2. Mounting frame work 114 mounts the printheads as recited in col. 6, lines 1-8. Figure 3 shows the frame mounting of feeder 132.

The motivation for frame mounting the hoppers is the same as given in the rejection of claim 1. The ink jets 120 of Graushar read on claim 6.

Regarding claim 5, Graushar teaches plural pockets at col. 4, line 10. Use of just two hoppers is not expressly set forth in claim 5 and in any event would be a design consideration dependent on the customized signature products requirements.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art cited above in the rejection of claim 1 and further in view of Kleineberg. Rana at

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col. 3, lines 13-17 teaches using the Kleineberg feed out drum for each hopper. See the description of the pickup drum of Kleineberg at col.2, lines 1-15. Graushar did not give examples of his feed out mechanisms from the hoppers. It would have been obvious to use the Kleineberg drum as taught by Rana as such was well known and conventional in the art to ensure one signature feed out per cycle. See col.3. lines 18-21 of Rana.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art cited above in the rejection of claim 5 and further in view of Riley et al. Riley et al teaches a programmed control selectively operates the hopper feeders.

The abstract states the entire collecting line is controlled by a programmable controller. Column 4, lines 52-64 describes signature removal under the programmable controller. See col. 6, lines 63-69 concerning computer 100 controlling all operations associated with each collecting station. Selective hopper operation is based on codes used by the control system. See col. 6, lines 45-49.

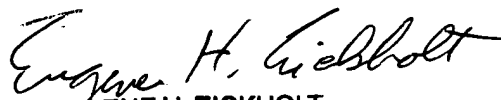
It would have been obvious to apply the Riley et al computer controlled signature collecting and binding system to the Graushar system to gain the many advantages of such automation such as those set forth in the last sentence of the abstract of Riley et al.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A shortened statutory period of 3 months is set to respond.

Eickholt/ds

07/13/04

  
EUGENE H. EICKHOLT  
PRIMARY EXAMINER